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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/173,858	10/16/1998	BART ALAN MELTZER	OIN 1004-1	4734
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HAYNES BEFFEL & WOLFELD LLP P O BOX 366 HALF MOON BAY, CA 94019			EXAMINER HUYNH, CONG LAC T	
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>		<b>Applicant(s)</b>	
	09/173,858		MELTZER ET AL.	
	<b>Examiner</b>		<b>Art Unit</b>	
	Cong-Lac Huynh		2178	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 23 July 2007.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-16 and 61-72 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 and 61-72 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>7/23/07</u> . | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

1. Applicant is hereby noted that the previous office action mailed on 10/3/07 is vacated. This action is responsive to the RCE filed on 7/23/07 to the application filed on 10/16/98.
2. Claims 1-16, 61-72 are pending in the case. Claims 1 and 61 are independent claims.
3. Claims 1-16 and 61-72 are under the principle of Res Judicata. The examiner's rejection of the above claims was affirmed at the Board of Appeals on 8/31/06. The instant claims have not been amended and are a duplicate of the claims presented earlier to the Board of Appeals. See MPEP 706.03 (w).

The issues decided by the Board are the same as those presented here, namely whether appellants had possession of the invention before the critical date by presenting evidence purportedly demonstrating an actual reduction to practice prior to March 11, 1998. The Board decided this issue stating, "After careful consideration of the evidence before us, we conclude that appellants have *failed* to provide a factual showing that the embodiment relied upon actually worked for its intended purpose as required to demonstrate an actual reduction to practice.

Furthermore, we find that appellants have failed to completely read the language of the instant claims on the proffered Exhibit A evidence provided in the declaration. In particular, we note that appellants have failed to point to specific portions of Exhibit A that demonstrate actual reduction to practice of the instant claimed "interpretation information providing a definition of an input document, and a definition of an output

document, the definitions of the input and output documents comprising respective descriptions of sets of storage units and logical structures for the sets of storage units" [claim 1, emphasis added]. While we recognize that XML (i.e., Extensible Markup Language) may provide Document Type Definitions (see e.g., W3C, p. 9, §2.8), the mere use of XML does not disclose input and output documents, per se. We have considered appellants' argument that the "forms and messages" disclosed in Exhibit A correspond to "input and output messages or documents" as part of CBL [brief, page 8, emphasis added]. However, we note that appellants have *failed* to provide a copy of the CBL first draft to be considered as evidence of actual reduction to practice.

We recognize that an accompanying exhibit need not support all claimed limitations, provided that any missing limitation is supported by the declaration itself. Ex parte Ovshinsky, 10 USPQ2d 1075 (Bd. Pat. App. & Inter. 1989) [emphasis added]. In the instant case, we note that appellants have also failed to explain how dependent claims 2-16 and 62-72 are supported by Exhibit A. In the alternative, appellants have *failed* to provide support for the missing dependent claim limitations in the declaration itself, so as to conclusively show possession of the complete instant claimed invention before the critical date. For at least the aforementioned reasons, we conclude that the character and weight of the evidence submitted pursuant to 37 C.F.R. § 1.131(b) is insufficient to show actual reduction to practice before the critical date of Sept. 1998. Accordingly, we consider the McKendrick reference as prior art, *infra*."

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identical disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 1-16, 61-72 remain rejected under 35 U.S.C. 103(a) as being unpatentable over McKendrick, *Banks begin to play with XML*, Bank Technology News, Sep 1998, Vol. 11, Iss. 9, pg. 6, 2 pgs, in view of W3C, *Extensible Markup Language (XML) 1.0*, 2/10/98, pages 1-37 (from the IDSs).

Regarding independent claim 1, McKendrick discloses:

- a machine-readable specification of an interface to transaction processes stored in memory accessible by at least one node in the network, including interpretation information providing a definition of an input document, and a definition of an output document (pages 1-2: McKendrick discloses applying XML in financial area to provide better bank services and utilizing XML for on-line business transactions involved with manipulation and transfer of data in the Internet such as purchase orders, invoices, and customer information. The purchase orders are considered as input documents, and the invoices are considered as output documents of the purchase orders in business transactions. Since the purchase orders as well as the invoices, which are the input and output documents, are in XML, they definitely include information providing the definition for such a document according to XML structures. And since the transaction documents are in XML format, these documents are machine-readable documents and should be stored in memory of a server accessible by at least one node in the network)

McKendrick does not explicitly disclose that the definitions of the input document and the output document comprising respective descriptions of sets of storage units and logical structures for the sets of storage units.

W3C discloses that each XML document comprises respective descriptions of set of storage units and logical structures for the set of storage units (page 3, Introduction: "XML documents are made up of *storage units* called entities, which contain either *parsed or unparsed data*. Parsed data is made up of characters, some of which form

character data, and some of which form *markup*. *Markup encodes a description of the document's storage layout and logical structure*. XML provides a mechanism to impose constraints on the storage layout and logical structure.")

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to have combined McKendrick into W3C for the following reason.

McKendrick discloses the transaction documents such as the purchase orders and the invoices in XML format for a business transaction over the Internet where a user can search and buy an item on-line, and W3C discloses the structures of an XML document which comprises storage units and the logical structures for the set of storage units.

This motivates to combine W3C into McKendrick for supporting the business transaction documents in XML format using the XML characteristics disclosed in W3C.

Regarding claim 2, which is dependent on claim 1, McKindrick does not disclose that the interpretation information includes data type specification for at least one logical structure in the definitions of the input and output document.

W3C discloses that each XML document contains one or more elements which are delimited by starts-tags and end-tags, and each element has a *type* identified by name called generic identifier and may have a set of *attribute specification* (page 13, Logical structure).

As mentioned in claim 1, since the documents used in the purchase transaction in McKindrick are in XML format, these documents inherit the features of a general XML

document as disclosed in W3C. This is applied for all the claims relating to the transaction document structures and W3C is used for rejecting.

Regarding claim 3, which is dependent on claim 1, W3C discloses that the interpretation information includes at least one data structure mapping predefined sets of storage units for a particular logical structure in the definition of the input and output documents, to respective entries in a list (pages 14-17).

Regarding claims 4 and 5, which are dependent on claim 1, McKindrick and W3C do not disclose explicitly that a repository in memory accessible by at least one node in the network storing a library of logical structures, interpretation information for logical structures, and the identifier of a transaction. However, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to have modified McKindrick and W3C to include a repository in memory for storing logical structures and the identifier of a transaction interface since it was well known in the art that any defined data for a program in a network should have a name for identifying and should be stored in a memory of a server for using later on such as retrieving data, identifying data, or manipulating data.

Regarding claim 6, which is dependent on claim 1, W3C discloses that the machine readable specification includes a document compliant with a definition of an interface document including logical structures for storing an identifier of the interface, and for



storing at least one of specifications and references to specifications of a set of one or more transactions supported by the interface (page 13).

Regarding claim 7, which is dependent on claim 6, McKindrick does not disclose a reference to a specification of a particular transaction, and the specification of the particular transaction includes a document including logical structures for storing at least one of definitions and references to definitions input and output documents for the particular transaction. Instead, McKindrick discloses *applying XML for business-to-business transaction where data such as purchase orders and invoices are manipulated and transferred over the Internet* (page 2).

W3C discloses that each XML document comprises respective descriptions of set of storage units and logical structures for the set of storage units (page 3, Introduction: "XML documents are made up of *storage units* called entities, which contain either *parsed or unparsed data*. Parsed data is made up of characters, some of which form character data, and some of which form *markup*. *Markup encodes a description of the document's storage layout and logical structure*. XML provides a mechanism to impose constraints on the storage layout and logical structure.")

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to have combined W3C into McKindrick to include a reference to a specification of a particular transaction which has logical structures for storing at least one of definitions and references to documents as in W3C for the particular business transaction as in McKindrick since a reference is considered as a name or an identifier

and the transaction documents in McKindrick such as the purchase orders and the invoices, considered as the input and output documents, must have a document name for identifying purpose.

Regarding claim 8, which is dependent on claim 1, W3C discloses that the storage units comprise parsed data (page 3, Introduction: "XML documents are made up storage units called entities, which contain either parsed or unparsed data...").

Regarding claim 9, which is dependent on claim 1, McKindrick does not explicitly disclose the parsed data in at least one of the input and output documents comprises:

- character data encoding text characters in the one of the input and output document
- markup data identifying sets of storage units according to the logical structure of the one of the input and output documents

Instead McKindrick discloses the business transactions involved with manipulation and transfer data such as purchase orders and invoices where invoices are considered as the output documents produced from the data portion of the purchase orders, which are considered as the input document (pages 1-2).

W3C discloses that the parsed data comprises:

- character data encoding text characters in XML documents (page 3, Introduction: "*XML documents* are made up storage units ...*Parsed data* is made up characters, some of which form *character data* ..."; page 6, Characters: "A

parsed entity contains text, a sequence of characters, which may represent markup or character data

- markup data identifying sets of storage units according to the logical structure of XML documents (page 3, Introduction: "*XML documents are made up storage units ... Parsed data is made up characters, some of which form character data, and some of which form markup. Markup encodes a description of the document's storage layout and logical structure ...*")

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to have combined W3C into McKindrick since the XML business documents in McKindrick which function as input and output documents should comprise parsed data with claimed features since these features are characteristics of an XML document as taught in W3C.

Regarding claim 10, which is dependent on claim 9, W3C discloses that at least one of the sets of storage units encodes a plurality of text characters providing a natural language word (page 6, Document, page 7, Characters and page 8, Character Data and Markup: since the storage units encodes by character data and markup which are text, the storage units provide a natural language word).

Regarding claim 11, which is dependent on claim 8, W3C discloses that the interpretation information for at least one of the sets of storage units identified by a particular logical structure of at least one of the input and output documents, encodes respective definitions for sets of parsed characters (page 9: "the function of the markup

in an XML document is to describe its storage and logical structure and to associate attribute-value pairs with its logical structures. XML provides a mechanism, the document type declaration, to *define constraints on the logical structure* and to support the use of predefined storage units ... the XML document type declaration contains or points to markup declarations that provide a grammar for a class of documents. This grammar is known as a *document type definition, or DTD ...*).

Regarding claim 12, which is dependent on claim 8, W3C discloses that the storage units comprise unparsed data (page 3, Introduction: "XML documents are made up storage units called entities, which contain either parsed or unparsed data..." page 20, Physical Structures).

Regarding claim 13, which is dependent on claim 1, as mentioned in claims 4 and 5 above, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to have modified McKindrick and W3C to include a repository in memory for storing all data related to the purchase transactions since it was well known in the art that any defined data for a program in a network should be stored in a memory of a server for using later on such as retrieving data, identifying data, or manipulating data.

Regarding claim 14, which is dependent on claim 13, W3C discloses that the repository of document types includes a document type for identifying participant process in the

network (page 9: "XML provides a mechanism, the document type declaration, to define constraints on the logical structure and to support the use of predefined storage units").

Regarding claim 15, which is dependent on claim 1, W3C discloses that the definitions of the input and output documents comprise document type definitions compliant with a standard Extensible Markup Language XML (page 9: "XML provides a mechanism, the document type declaration, to define constraints on the logical structure and to support the use of predefined storage units ... the XML document type declaration contains or points to markup declarations that provide a grammar for a class of documents. This grammar is known as a document type definition, DTD ... the DTD fro a document consists of both subsets taken together").

Regarding claim 16, which is dependent on claim 1, W3C discloses that the machine readable data structure including interpretation information comprises a document organized according to a document type definition compliant with a standard Extensible Markup Language XML (page 9: an XML document is a machine readable data structure organized according to a DTD compliant with the standard Extensible Markup Language).

Regarding independent claim 61, McKindrick does not disclose explicitly:

- defining a machine readable definition of an input document for a node in the network including resources to execute a process in the transaction, and a

machine readable definition of an output document for the node, the definitions the input and output documents comprising respective descriptions of sets of storage units and logical structures for the sets of storage units

- providing interpretation information for the logical structures to the node

Instead McKindrick discloses applying XML in financial area to provide better bank services and utilizing XML for on-line business transactions involved with manipulation and transfer of data in the Internet such as purchase orders, invoices, and customer information (pages 1-2). The purchase orders in McKindrick are considered as input documents, and the invoices are considered as output documents of the purchase orders in business transactions. Since the purchase orders as well as the invoices, which are the input and output documents, are in XML format, they definitely include information to provide the definition for said documents according to XML structures. And since the transaction documents are in XML format, these documents are machine-readable documents and should be stored in memory of a server accessible by at least one node in the network.

W3C discloses:

- defining a machine readable definitions of documents comprising respective descriptions of sets of storage units and logical structures for the sets of storage units (page 3, Introduction and page 9: XML documents are made up of storage units which contain either parsed or unparsed data where parsed data is made up characters some of which form character data, and some of which form

markup to encode a *description of the document storage layout and logical structures*).

- providing interpretation information for the logical structures (page 9: the function of the markup in an XML document is to associate *attribute-value* pairs with its logical structures)

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to have combined McKendrick into W3C for the following reason.

McKendrick discloses the transaction documents such as the purchase orders and the invoices in XML format for a business transaction over the Internet where a user can search and buy an item on-line and W3C discloses the structures of an XML document which comprises storage units and the logical structures for the set of storage units.

This motivates to combine W3C into McKendrick for supporting the business transaction documents in XML format using the XML characteristics disclosed in W3C.

Claims 62-71 are for a method of claims 2-5, 8-12, 15, and are rejected under the same rationale.

Regarding claim 72, which is dependent on claim 61, McKendrick and W3C do not disclose:

- providing a parser to generate event signals in response to logical structures in the definition of the input document

- providing event listener program which respond to the event signals to execute the process

Instead McKindrick discloses the Internet business transactions via purchase orders and invoices in XML format where the purchase orders and the invoices are considered as input documents and output documents (pages 1-2).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to have modified McKindrick to include "providing a parser to generate event signals in response to logical structures..." and "providing event listener program which respond to the event signals to execute the process" for the following reason. The fact that McKindrick executes the transaction program by running the XML transaction documents which include logical structures suggests said parser and said event listener program as claimed, which are the must programs in the executing process.

### ***Response to Arguments***

7. Applicant's arguments filed 7/23/07 have been fully considered but they are not persuasive.

Applicants provide the new evidence to remove the reference McKendrick in the 103 rejection. However, McKendrick is maintained in the rejections in combination with W3C for the following reason.

*The affidavit or declaration and exhibits must clearly explain which facts or data applicant is relying on to show completion of his or her invention prior to the particular date. Vague and general statements in broad terms about what the exhibits describe along with a general assertion that the exhibits describe a reduction to practice "amounts essentially to mere pleading, unsupported by proof or a showing of facts" and,*



*thus, does not satisfy the requirements of 37 CFR 1.131(b). In re Borkowski, 505 F.2d 713, 184 USPQ 29 (CCPA 1974). Applicant must give a clear explanation of the exhibits pointing out exactly what facts are established and relied on by applicant. 505 F.2d at 718-19, 184 USPQ at 33. See also In re Harry, 333 F.2d 920, 142 USPQ 164 (CCPA 1964) (Affidavit "asserts that facts exist but does not tell what they are or when they occurred.") (MPEP 715.07 [R-3]).*

Applicants submitted the mapping of the language of the instant claims of the application to slide 30, one of Glushko's slides at his presentation on July 25, 1998.

This submission is not proper since:

- the claim mapping as required by the Board should be included in the declaration signed by inventors to show the possession of the inventors on the invented subject matter
- document used to make the claim mapping should be referred in the declaration
- in mapping, it needs to point out only which subject matter of the claims is mapped with a portion in the document that Applicants relied on, in this case, slide 30, *not what the Examiner relied on*

The Board notes that "McKendrick is considered as a printed publication published in the United States that qualifies as prior art under 35 U.S.C. 102 (a), and therefore may be antedated by a declaration that complies with the requirements of 37 C.F.R. 1.131 (b)" (DoA). The declaration does not comply with the requirements of 37 C.F.R. 1.131(b), and so does not predate the McKendrick reference.

Regarding new evidence of reduction to practice, Applicants shows that "CBL development was well under way prior to the May [sic] 11, 1998 date given in the declaration"(Remarks, page 14).

However, this merely shows that CBL had been developing until September 1998, when CBL 1.1 was released to public use at no cost.

In the article in December 1999 "How XML Enables Internet Trading Communities and Marketplaces" at <http://www.infoloom.com/gcaconfs/WEB/philadelphia99/glushko.HTM> by Dr. Glushko, it is true that work on CBL began in 1997. However, Dr. Glushko admitted that the early versions of CBL struggled with technical problems:

*Work on CBL began in 1997, partly funded by a Department of Commerce's Advanced Technology Program research award on "Component-Based Commerce" to Veo Systems and three other firms [ATP]. Because of this research pedigree, early versions of CBL strove for logical completeness, expressiveness, and compactness to test the abstract modeling power of XML for electronic commerce and to identify requirements for development tools and runtime support.*

This indicates that the first draft of CBL, which is the early version of CBL in 1997, did not work and is not a completeness of the invention that Applicants relied on to show reduction to practice of the invention.

Applicants use the presentation by inventor Glushko on July 25, 1998 to show Glushko's actual reduction to practice two months before McKendrick.

The slides presented on that date are merely a PowerPoint document for presentation. They are not an evidence of a complete product that is guaranteed that it worked with testing.

*"In general, proof of actual reduction to practice requires a showing that the apparatus actually existed and worked for its intended purpose. However, "there are some devices so simple that a mere construction of them is all that is necessary to constitute reduction to practice." In re Asahi/America Inc., \*\*>68 F.3d 442, 37 USPQ2d 1204, 1206< (Fed. Cir. 1995) (Citing Newkirk v. \*>Lulejian<, 825 F.2d 1581, 3USPQ2d 1793 (Fed. Cir.1987) and Sachs v. Wadsworth, 48 F.2d 928, 929, 9 USPQ 252, 253 (CCPA 1931). The claimed restraint coupling held to be so simple a device that mere construction of it was sufficient to constitute reduction to practice. Photographs, coupled with articles and a technical report describing the coupling in detail were sufficient to show reduction to practice.)" (MPEP 715.07 III)"*

*"For an actual reduction to practice, the invention must have been sufficiently tested to demonstrate that it will work for its intended purpose, but it need not be in a commercially satisfactory stage of development. If a device is so simple, and its purpose and efficacy so obvious, construction alone is sufficient to demonstrate workability. King Instrument Corp. v. Otari Corp., 767 F.2d 853, 860, 226 USPQ 402, 407 (Fed. Cir. 1985). For additional cases pertaining to the requirements necessary to establish actual reduction to practice see DSL Dynamic Sciences, Ltd. v. Union Switch & Signal, Inc., 928 F.2d 1122, 1126, 18 USPQ2d 1152, 1155 (Fed. Cir. 1991) ("events occurring after an alleged actual reduction to practice can call into question whether reduction to practice has in fact occurred"); Corona v. Dovan, 273 U.S. 692, 1928 C.D. 252 (1928) ("A process is reduced to practice when it is successfully performed. A machine is reduced to practice when it is assembled, adjusted and used. A manufacture [i.e., article of manufacture] is reduced to practice when it is completely manufactured. A composition of matter is reduced to practice when it is completely composed." 1928 C.D. at 262-263 (emphasis added).); Fitzgerald v. Arbib, 268 F.2d 763, 765-66, 122 USPQ 530, 531-32 (CCPA 1959) ("the reduction to practice of a three-dimensional design invention requires the production of an article embodying that design" in "other than a mere drawing")" (MPEP 2138.05).*

It is noted that CBL 1.1 was released in September 1998 (Remarks, page 14), two months after Dr. Glushko's presentation July 25, 1998. The invention may be still under developing at the time of presentation.

Therefore, the second version of CBL, which is CBL 1.1, does not show reduction to practice prior the effective date of McKendrick reference.

It is noted that the next version of CBL, CBL 1.2 “was completed in November 1998” (Terry Allen, *Common Business Library (CBL)*, May 1999) after the filing date of the invention 10/16/98.

Also in the article of Dr. Glushko, CBL 2.0, which is the most successful version of CBL, was actually formed in January 1999, when Commerce One acquired Veo System:

*The acquisition of Veo Systems by Commerce One in January 1999 introduced to CBL a requirement for interoperability with EDI. CBL 2.0, in line with the lessons learned from CBL 1.0, aims for less abstraction, even if it means redundancy or less expressiveness, and greater compatibility with EDI standards and semantics. Using standard data element semantics provides a strong non-proprietary and interoperable semantic foundation for CBL, and gives companies using EDI today a clear migration path in CBL for transforming EDI applications to XML. CBL is freely available in repositories run by Commerce One as part of marketsite.net, as well as well as through those operated by xml.org and Biztalk.org.*

It is noted that January 1999 is after the filing date of the instant application. Therefore, according to the new evidence and related articles it appears that there is no actual reduction to practice prior September 1998. Accordingly, there was no reduction to practice prior the effective date of the McKendrick reference.

Only the filling of a US patent application which complies with the disclosure requirement of 35 USC 112 constitutes a constructive reduction to practice. A slide for presentation that is merely a written description, no matter how complete, has not been made the subject of a US patent application and does not qualify as reduction to practice.

Accordingly, Applicants have not established prior invention. The rejection is maintained.

Applicants provide the article *XML: Enabling Next-Generation Web Applications* to show where the passage quoted by McKendrick (Remarks, page 30) is included and to show that in the article, Microsoft teaches and promotes a Remote Procedure Call (RPC) use of XML and did not use an input document and an output document.

In response, it is noted that in the provided article, Remote Procedure Call (RPC) is mentioned and the business applications involving manipulation and transfer data such as purchase orders, invoices, and customer information using XML is also mentioned. The latter is what McKendrick quoted and used in his article wherein the purchase orders and the invoices are input documents and output documents. And that is the information that the Examiner would like to point out that XML is used to implement purchases orders and invoices in business applications.

### ***Conclusion***

8. This is a RCE of applicant's earlier Application No. 09/173,858. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Wang et al. (US 6,490,217). Wang (US 5,917,913).

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10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cong-Lac Huynh whose telephone number is 571-272-4125. The examiner can normally be reached on Mon-Fri (8:30-6:00).

11. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong can be reached on 571-272-4124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-4125.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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